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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/765,901	01/07/97	PRAT	E 004900-148

IM62/0915

BURNS DOANE SWECKER AND MATHIS  
GEORGE MASON BUILDING  
WASHINGTON AND PRINCE STREETS  
P O BOX 1404  
ALEXANDRIA VA 22313-1404

EXAMINER

HENDRICKSON, S  
ART UNIT PAPER NUMBER

1754

DATE MAILED: 09/15/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on March 7/12/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 22-46 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 22-46 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

☒ Notice of Reference PTO-892

No(s) \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The request filed on 7/12/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/765,901 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 22-37 and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chevallier et al. '570.

Chevallier teaches in col. 2 lines 35-45, col. 4 line 20-col. 5 line 25, col. 11 lines 5-20 and col. 22 lines 1-10 reacting silicate and acid (and optionally alumina) in the claimed concentrations, then adding more silicate and acid together to pH 4-6, filtering, ultrasonic deagglomeration and adding water to make a 4% silica solution.

Concerning claim 39, a quantity is not patentably distinct from "less than" that quantity; see *Titanium Metals v. Banner* 227 USPQ 773.

Chevallier differs in silica concentration of final product, however suggests that a concentration of about 20% is desirable.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a silica product in the process of Chevallier having the claimed silica content because doing so makes a concentrated solution which is easy to handle, ship and use efficiently.

Concerning claims 34, 35, 42 and 43, the examiner takes Official Notice that the claimed crumbling is old and known in the art; using them is an obvious expedient to perform the deagglomeration taught by Chevallier.

Claim 36 is met when the process is repeated upon a 'heel' portion.

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Claims 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chevallier et al. '570 as applied to claims 22-37 and 39-45 above, and further in view of Cox et al.

Chevallier does not teach washing with organic solvent, however Cox teaches doing so in col. 4 lines 25-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to wash the product of Chevallier with organic solvent suggested by Cox because doing so makes a pure material desired by Chevallier.

Applicant's arguments filed through 7/12/99 have been fully considered but are not persuasive.

Concerning Chevallier, no patentable distinction in the size of claim 39 is seen, as explained. No differences in the viscosity have been shown. As it is applicant's position that water of hydration is sufficient to form a suspension, then so too will the water of the silica of the reference.

Therefore, the reference does- even without the test which teaches suspension formation- render obvious the formation of a suspension. That Chevallier forms a suspension in a test does not make the suspension-forming step patentably distinct; see *In re Dillon* 16 USPQ2d 1897. Finally, the teaching of a colloidal mill indicates forming a suspension. Therefore, it appears that the reference renders obvious the claimed steps.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

A handwritten signature in black ink, appearing to read 'Stuart Hendrickson', with a stylized flourish at the end.

Stuart Hendrickson  
examiner Art Unit 1754